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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,623	09/15/2003	David Vella	4032.001	9766

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EXAMINER

SLACK, NAKO N

ART UNIT PAPER NUMBER

3635

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/662,623

Applicant(s)

VELLA, DAVID

Examiner

Naoko Slack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

In view of applicant's amendment received July 15, 2005, claim 1 has been canceled as requested, claims 2-10 have been amended, and new claim 11 has been entered. Claims 2-11 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application 2002/0157294A1 to Stanley in view of US Patent 6, 131,345 to Pelusio.

Claim 11:

Stanley discloses a custom made magnetic pad for use on metal doors such as garage doors (paragraph 0010), the magnetic pad comprising graphical representations that are coordinated and arranged in an overall pattern (paragraph 0006). The pad comprises a sheet with a first side having a magnetic material (24, Figure 4) and a second side which displays a graphic representation (25, Figure 4). While Stanley does not specify that the graphic representation depicts a garage window, Stanley's decorative subject matter may take the form of any graphical representation (paragraph

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000). Furthermore, decorative window facades adhered to garage doors are known in the art, as taught by Pelusio.

Pelusio discloses a coordinated arrangement of window facades adhered to a garage door to simulate built-in windows. In view of Pelusio, it would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made to form Stanley's magnetic pad with a graphic representation of a window facade, as Stanley states that the decorative matter may take the form of any graphic representations (paragraph 0008) and that a plurality of magnetic appliques may be arranged in a selective and desired pattern or arrangement on a garage door to produce an overall graphic effect (paragraph 0012).

Applicant argues that the Stanley reference does not specify a particular design, namely a window facade design. However, arguments regarding decorative design choice are not persuasive in utility applications. Decorative design is a matter of individual preference in utility applications. A utility patent protects the way an article is used and works (35 USC 101), while a design patent protects the way an article looks (35 USC 171) See MPEP 1502.01[R-2].

Stanley clearly states that any graphic representation may be printed on the magnetic sheet (paragraph 0007) to produce a coordinated arrangement on a garage door (paragraphs 0006 and 0010). And in view of Pelusio, one of ordinary skill would consider printing a decorative window facade design on Stanley's magnetic sheet.

Applicant also states that Pelusio's facades are attached by drilling holes. However, Pelusio clearly states that the window facades may be applied with

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"adhesives or the like" (column 2, line 49), as homeowners prefer not to cut openings into their garage doors (column 1, lines 35-36).

Claim 2:

Stanley's magnetic pad further comprises a protective coating (27, Figure 4) adjacent the second side.

Claim 3:

Stanley discloses that the graphic representation may be formed by printing (paragraph 0013). It should be noted that claim 3 is considered a product-by-process claim; therefore, determination of patentability is based on the product itself. See MPEP 2113. The patentability of the product does not depend on its method of production. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985)

Claim 4:

Stanley discloses that the pad is shaped by cutting the shape of the desired graphics (paragraph 0026). Again, it should be noted that claim 4 is considered a product-by-process claim; therefore, determination of patentability is based on the product itself. See MPEP 2113. The patentability of the product does not depend on its method of production. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985)

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Claim 5:

Stanley discloses a custom made magnetic pad for use on metal doors such as garage doors (paragraph 0010), the magnetic pad comprising graphical representations that are coordinated and arranged in an overall pattern (paragraph 0006). The pad comprises a sheet with a first side having a magnetic material (24, Figure 4) and a second side which displays a graphic representation (25, Figure 4). While Stanley does not specify that the graphic representation depicts a garage door window, Stanley's decorative subject matter may take the form of any graphical representation (paragraph 0007). Furthermore, decorative window facades adhered to garage doors are known in the art.

Pelusio discloses a coordinated arrangement of window facades adhered to a garage door to simulate built-in windows. In view of Pelusio, it would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made to form Stanley's magnetic pad with a graphic representation of a window facade, as Stanley states that the decorative matter may take the form of any graphic representations (paragraph 0008) and that a plurality of magnetic appliqués may be arranged in a selective and desired pattern or arrangement on a garage door to produce an overall graphic effect (paragraph 0012).

While Stanley does not disclose that the graphic representation depicts a window with a grille and a plurality of geometric panels, Pelusio discloses a plurality of garage window facades designed with the appearance of garage window grilles and geometric panes to simulate built-in windows. In view of Pelusio, it would have been obvious to

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one of ordinary skill in the art at the time the invention was made to form Stanley's magnetic pad with a graphic representation of a window, as Stanley states that the shape of the magnetic sheet may take the form of any graphic representation (paragraph 0025).

Claim 6:

Stanley discloses a method for enhancing the appearance of a metallic surface comprising the step of placing a decorative metallic applique on the metallic surface, wherein the applique is cut to a user-defined shape and size (paragraph 0026) and comprises a sheet having a first side having a magnetic material (24, Figure 4) and a second side, wherein the second side displays a graphic representation (25, Figure 4) which is applied by paint or the like (paragraph 0024).

While Stanley does not disclose that the graphic representation depicts a window with a grille and a plurality of geometric panels, Pelusio discloses a plurality of garage window facades designed with grilles and geometric panes to simulate built-in windows. In view of Pelusio, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form Stanley's magnetic pad with a graphic representation of a window, as Stanley states that the shape of the magnetic sheet may take the form of any graphic representation (paragraph 0025).

Claim 7:

While Pelusio does not state that the grille and the plurality of geometric panels are color-coordinated to match the metallic surface of the underlying garage door, color-coordination is a matter of obvious design choice to one of ordinary skill in the art to

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satisfy aesthetic considerations. Pelusio is motivated to provide an aesthetically pleasing garage door (column 2, lines 40-43).

Claim 8:

Stanley discloses a custom made magnetic pad for use on metal doors such as garage doors (paragraph 10), the pad comprising a sheet cut to a user-defined shape and size (paragraph 26), the sheet having a first side of magnetic material (24, Figure 4) and a second side that displays a graphic representation.

While Stanley does not disclose that the graphic representation comprises a design of a garage door window with a grille and a plurality of geometric panels, Pelusio discloses a plurality of garage door window facades designed with grilles and geometric panes to simulate built-in windows. In view of Pelusio, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form Stanley's magnetic pad with a graphic representation of a window, as Stanley states that the shape of the magnetic sheet may take the form of any graphic representation (paragraph 0025).

Claim 9:

While Pelusio does not state that the grille and the plurality of geometric panels are color-coordinated to match the metallic surface of the underlying garage door, color-coordination is a matter of obvious design choice to one of ordinary skill in the art to satisfy aesthetic considerations. Pelusio is motivated to provide an aesthetically pleasing garage door (column 2, lines 40-43).

Claim 10:

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Stanley discloses a custom made magnetic pad for use on metal doors such as garage doors (paragraph 0010), the pad comprising a sheet having a first side of magnetic material (24, Figure 4) and a second side that displays a graphic representation on a decorative sheet (25, Figure 4).

While Stanley does not disclose that the graphic representation comprises a design of a window with a grille and a plurality of geometric panels, Pelusio discloses a plurality of garage window facades designed with grilles and geometric panes to simulate built-in windows. In view of Pelusio, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form Stanley's magnetic pad with a graphic representation of a window, as Stanley states that the shape of the magnetic sheet may take the form of any graphic representation (paragraph 0025).

Final

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naoko Slack whose current telephone number is (703) 305-0315. After 11 April 2005, the new telephone number will be (571) 272-6848. The examiner can normally be reached on Mon-Fri (6:00 am-2:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (703) 308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naoko Slack
Primary Examiner
Art Unit 3635

NS
September 22, 2005